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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,524	04/20/2000	Charles Eric Hunter	WT-8	5419
35856	7590	10/20/2004	EXAMINER	
LAVA GROUP LAW BY SMITH & FROHWEIN, LLC			KOENIG, ANDREW Y	
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ATLANTA, GA 30356			PAPER NUMBER	

2611

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,524

Applicant(s)

HUNTER ET AL.

Examiner

Andrew Y Koenig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-50,56,57,60-64,107 and 108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-50,56,57,60-64,107 and 108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 30-50,56,57,60-64,107 and 108 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments filed 10 November 2003 have been fully considered but they are not fully persuasive.

On page 10, paragraph 3 of the applicant's response, the applicant argues that Russo does not teach the claimed "transmitting additional information to the customer along with the plurality of the digital data content." The examiner disagrees; Russo teaches transmitting supplemental information (which is the claimed additional information) to the customer along with the digital data content (col. 8-9, ll. 55-2), which equates to transmitting additional information to the customer along with the plurality of the digital data content.

On page 11, last paragraph, the applicant argues that Russo teaches billing the customer, but is silent as to crediting the provider upon displaying of digital content. The examiner disagrees; by billing the received programming, which credits a provider of digital data content, wherein Russo will credit the provider locally, then pay at a later time (col. 6, ll. 34-53). The claims do not require the exchange of money upon display, but merely credit upon display.

Claim Objections

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3. Claims 1-29 51-55 58, 59, 65-106, and 109-110 are objected to because of the following informalities:

The claim identifiers for claims 1-29 51-55 58, 59, 65-106, and 109-110 indicate the status to be "withdrawn," however these claims should appear as "cancelled."

Claims 31-32, 35, 37, 39, 41-45, 47-49 are objected to because of the following informalities:

The claim identifiers for claims 31-32, 35, 37, 39, 41-45, 47-49 are missing, the however these claims should appear as "previously presented."

4. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 30, 31, 34-38, 40, 43, and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,619,247 to Russo.

Regarding claim 30, Russo teaches transmitting movies and music selections to customers via a cable television input or a satellite (col. 6, ll. 9-12, col. 7, ll. 29-34), and permitting the user to pre-select and record a movie, along with automatically recording

a movie (Abstract, col. 9-10, ll. 38-10). Russo teaches transmitting supplemental information (which is the claimed additional information) to the customer along with the digital data content (col. 8-9, ll. 55-2).

Furthermore, Russo teaches playing back the preselected movie, (figure 1; col. 3-4, ll. 65-2). Russo teaches communicating the movie selection to a program provider (col. 6, ll. 9-12), which equates to a central controller system, the program provider of also bills the customers for the recorded selections and movies that actually played (col. 5, ll. 1-10).

Regarding claim 31, Russo teaches downloading supplemental data, such as future schedule information (col. 8, ll. 55-61), which equates to digital data content listing.

Regarding claim 34, Russo teaches using a key to decode a program to permit viewing (col. 6, ll. 12-24, 46-53), which reads on preventing the preselected and stored content from being displayed on unauthorized devices.

Regarding claim 35, Russo teaches using a key to decode a program to permit viewing (col. 6, ll. 12-24, 46-53), wherein the content has some form of coding to prevent the display on unauthorized devices.

Regarding claim 36, Russo teaches using a key to decode a program to permit viewing (col. 6, ll. 12-24, 46-53), which reads enabling the display of the content.

Regarding claim 37, Russo teaches using a key to decode a program to permit viewing (col. 6, ll. 12-24, 46-53), wherein the key equates to an enabling signal.

Regarding claim 38, Russo teaches sending a key to a specific user (col. 6, ll. 12-16), which reads on altering the preselected and stored data to identify a particular customer.

Regarding claim 40, Russo teaches transmitting movies and music selections to customers via a cable television input or a satellite (col. 6, ll. 9-12), and permitting the user to pre-select and record a movie, along with automatically recording a movie (Abstract). Additionally, Russo teaches that it is within in the scope to include audio selections (col. 6-7, ll. 65-3). Furthermore, Russo teaches playing back the preselected movie, (figure 1; col. 3-4, ll. 65-2). Russo teaches communicating the movie selection to a program provider (col. 6, ll. 9-12), which equates to a central controller system, the program provider of also bills the customers for the recorded selections and movies that actually played (col. 5, ll. 1-10). Russo teaches using a key to decode a program to permit viewing (col. 6, ll. 12-24, 46-53), which reads on encoding the movies to permit playback with compatible playback devices. Russo teaches using a CD-ROM to store audio and video programs (col. 7, ll. 44-51) Russo teaches billing the customer based on their respective selections (col. 6, ll. 35-53). Russo teaches automatically selecting storage of additional information according to predetermined criteria, where the criteria are user preferences (col. 3, ll. 12-16, col. 9-10, ll. 38-10).

Regarding claim 43, Russo teaches customer preferences (col. 3, ll. 12-16).

Regarding claims 50, Russo teaches billing the customer based on their respective selections (col. 6, ll. 35-53), which equates to crediting a provider.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 5,682,206 to Wehmeyer et al.

Regarding claim 32, Russo teaches downloading supplemental data, such as future schedule information (col. 8, ll. 55-61), but is silent on periodically updating the additional data. Wehmeyer teaches periodic updates of supplemental program guide data of future schedule information (col. 4, ll. 43-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by periodically updating information as taught by Wehmeyer in order to maintain current records.

9. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 6,249,532 to Yoshikawa et al.

Regarding claim 46, Russo is silent on detecting data errors in the stored content. Yoshikawa teaches detecting errors (col. 9, ll. 34-43) in the received signal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by detecting errors as taught by Yoshikawa in order to correct the errors in the signal thereby creating a higher quality signal.

10. Claims 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 6,249,532 to Yoshikawa et al. in view of U.S. Patent 5,905,713 to Anderson et al.

Regarding claim 47, Russo is silent on informing the customer of detected data errors. Anderson teaches displaying errors to a computer interface (col. 6, ll. 44-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by informing the user of detected errors as taught by Anderson in order permit the user to select the quality of the programming due to the error rates.

Regarding claim 48, Russo is silent on retransmissions of the content. Yoshikawa teaches retransmitting data in the event of errors (col. 9, ll. 34-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by retransmit data to replace errors as taught by Yoshikawa in order enhance the quality of the programming.

Regarding claim 49, Russo is silent on designating and informing the customer of the degree of errors. Anderson teaches selecting the types of errors (which equates to the claimed degree of errors) (col. 7, ll. 23-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by informing the user of the degree of detected errors as taught by Anderson in order permit the user to select the quality of the programming due to the error rates.

11. Claim 33, 41, and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 6,177,931 to Alexander et al. (Alexander).

Regarding claim 33, Russo teaches displaying information for selecting a program (col. 9-10, ll. 38-10). Russo is silent on displaying data content by category. Alexander teaches displaying content by category (fig. 7, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by displaying content by category as taught by Alexander in order to efficiently browse through programming.

Regarding claim 41, Russo teaches additional information but is silent on promotional information. Alexander teaches promotional information about programming (fig. 10A, 10B). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by displaying promotion information as taught by Alexander in order to encourage the user to select the program.

Regarding claims 44 and 45, Russo is silent on customer profile. Alexander teaches a profile and program suggestions (col. 30, ll. 54-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by implementing a profile and program suggestions as taught by Alexander in order to inform and aid the user in program selection.

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12. Claims 39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 6,522,769 to Rhoads et al. (Rhoads).

Regarding claim 39, Russo is silent on a digital watermark. Rhoads teaches a reconfigurable watermark detector, which can detect watermarks in video signals for security purposes (col. 1-2, ll. 49-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by using watermarks as taught by Rhoads in order to increase security and prevent unauthorized viewing.

Regarding claim 42, Russo is silent on the additional information is a soundtrack corresponding to the video image data. Rhoads teaches a watermark that permits the user to purchase the soundtrack to a movie (col. 13, ll. 5-8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by purchasing a soundtrack to a movie as taught by Rhoads in order to present extra opportunities to purchase the CD.

13. Claims 56 and 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 5,963,217 to Grayson et al.

Regarding claim 56, Russo is silent on a criteria is randomly on a periodic basis. Grayson teaches randomly selecting sections based on the profile (col. 8, ll. 18-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by randomly selecting content as taught by

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Grayson in order to expose the user to a variety of programming. Whereas it is recognized that Russo is Grayson are silent on performing the random selection periodically, Official Notice is taken that it is well known in the art to use periodic selections, such as periodically updating information in a schedule. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo and Grayson by providing periodic information in order to routinely present new information to the user.

Regarding claim 107, the limitations of claim 107 have been addressed in the discussion of claim 56. Russo teaches receiving movies and music selections to customers via a cable television input or a satellite (col. 6, ll. 9-12, col. 7, ll. 29-34), and permitting the user to pre-select and record a movie, along with automatically recording a movie into the high capacity storage (110) (which equates to the claimed memory) (Abstract, col. 9-10, ll. 38-10). Russo teaches a display generator (160) for informing the user of connected automatically connected and for display (col. 9-10, ll. 38-10).

14. Claims 57, 60, and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 5,734,720 to Salganicoff.

Regarding claim 57, Russo is silent on a criteria based on popularity. Salganicoff teaches using national popularity as a criterion in suggesting programming to a user (col. 48, ll. 27-45). Therefore, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify Russo by selecting based on popularity as taught by Salganicoff in order to expose the user to a variety of programming.

Regarding claim 60, Russo is teaches on transmitting classification information, comparing the classification information, and automatically selecting the programs to be stored (col. 3, ll. 12-16).

Regarding claim 108, the limitations of claim 108 have been addressed in the discussion of claim 57. Russo teaches receiving movies and music selections to customers via a cable television input or a satellite (col. 6, ll. 9-12, col. 7, ll. 29-34), and permitting the user to pre-select and record a movie, along with automatically recording a movie into the high capacity storage (110) (which equates to the claimed memory) (Abstract, col. 9-10, ll. 38-10). Russo teaches a display generator (160) for informing the user of connected automatically connected and for display (col. 9-10, ll. 38-10).

15. Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 5,734,720 to Salganicoff in view of U.S. Patent 6,804,825 to White et al.

Regarding claims 61 and 62, Russo is silent on overwriting the oldest stored data. White teaches deleting the oldest stored data (col. 9, ll. 32-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by deleting the oldest stored data as taught by White in order to remove content least desirable to the user.

Regarding claims 61 and 63, Russo is silent on overwriting the older released data. White teaches deleting the oldest stored data (col. 9, ll. 32-40), which equates to "older released data" in that the data is the oldest data transmitted (e.g. released) from the transmitter. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by deleting the older released data as taught by White in order to remove content least desirable to the user.

16. Claims 61 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 5,734,720 to Salganicoff in view of U.S. Patent Application Publication 2002/0056112 to Dureau et al.

Regarding claims 61 and 64, Russo is silent on overwriting the least fit preferences of the customer. Dureau teaches deleting the least fit preferences to make room for more programming (pg. 6, para. 0051). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by deleting the least fit preferences as taught by Dureau in order to remove content least desirable to the user thereby creating space for new programming.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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